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09/600,352	07/14/2000	WOLFGANG NEIFER	3046.052US0	2644

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

DEMICCO, MATTHEW R

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 08/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/600,352

Applicant(s)

NEIFER, WOLFGANG

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 62-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 62-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Specification***

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. The disclosure is objected to because of the following informalities: Page 7 cites claims that have been cancelled. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 84-85, 87 and 90 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,880,769 to Nemirofsky et al.

Regarding Claim 84, Nemirofsky discloses a wireless remote control device (See Figure 6a) for a communication module. Nemirofsky discloses a system wherein Pay Per View programming is available (Col. 5, Lines 28-35). A user account and PIN code entry is necessary to authorize the transaction (Col. 5, Lines 46-53). This reads on the claimed Conditional Access Module. Further, Nemirofsky discloses encryption means for encrypting control data to be transmitted to the communication module (Col. 4, Lines 20-25).

Regarding Claim 85, Nemirofsky discloses a system as stated above in Claim 84 wherein the CAM module comprises a chip-card reader (See Figure 5).

Regarding Claim 87, Nemirofsky discloses a system as stated above in Claim 84 wherein the encryption means comprise a chip-card reader (See Figure 5).

Regarding Claim 90, Nemirofsky discloses a system as stated above in Claim 84 wherein the communication module incorporates a user identification module. Multiple account information is stored on the smart card (Col. 4, Lines 50-61) and a user initiates a

financial transaction by providing input to the card (Col. 4, Lines 62-64) and entering a personal identification number (Col. 5, Lines 11-15).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 62-64, 68-69, 72-81 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,724,106 to Autry et al. in view of Nemirofsky et al.

Regarding Claim 62, Autry discloses a multimedia system (See Figure 1) comprising a display device (122), a base station (118) incorporating a receiver for multimedia transmissions and connected to the display device and a wireless remote control device (124). The base station has a plurality of personal computer card connectors (See Figure 3, 316-322) connected to a PCI bus (312). It is inherent that such a system has associated hardware and software functionality. Further, the system of Autry discloses a modem (322), which as is well known in the art, may be used to connect the computer to a network. Further the remote control device is used to directly control the network client computer (Col. 7, Lines 20-40) via a wireless link. What is not disclosed, however, is a communication module in a PC card format incorporating a network client computer and a wireless link. Nemirofsky discloses a communication module in a PC card format (See Figure 2) incorporating a network client (Col. 2, Lines 45-50) and a

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wireless interface (Col. 3, Lines 9-12). Nemirofsky is evidence that ordinary workers in the art would appreciate the ability to house a network controller and wireless interface in a PC smart card. Further, it is well known in the art that a computer system, such as the one disclosed by Autry with a data bus and a plurality of personal computer cards, that PC cards can be used as an alternative to full-sized cards for saving space. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Autry with the PC-card base network and wireless interface of Nemirofsky in order to reduce the footprint of the system through the use of credit-card sized devices.

Regarding Claim 63, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Nemirofsky further discloses that communication between the television device and the remote control may be encrypted (Col. 4, Lines 20-25). This reads on the claimed remote control device and communication module comprises encryption and decryption means for encrypted transmission of data at least from the remote control to the communication module.

Regarding Claim 64, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Nemirofsky further discloses a system wherein Pay Per View programming is available (Col. 5, Lines 28-35). A user account and PIN code entry is necessary to authorize the transaction (Col. 5, Lines 46-53). This reads on the claimed Conditional Access Module.

Regarding Claim 66, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Nemirofsky discloses a Conditional Access Module as stated above in

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Claim 64. The user enters a PIN code through the remote control device (See Figure 6a), which interfaces with the set top box to order Pay Per View programming as stated above. Because the remote/chip-card and set top box coordinate to initiate such a transaction, it is inherent that the remote control device incorporate some functions of the Conditional Access Module.

Regarding Claim 68, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Autry further discloses the use of a modem (See Figure 3) as stated above. Nemirofsky also discloses a modem (See Figure 4, 42) for connecting to a provider network.

Regarding Claim 69, Autry in view of Nemirofsky disclose a system as stated above in Claim 68. Nemirofsky further discloses a smart card with a wireless interface that supports wireless communication through a satellite or cellular network (Col. 3, Lines 9-12).

Regarding Claim 72, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Autry discloses a system wherein the remote control device generates control information and outputs it in the form of a control signal the control information selecting information from display information displayed on the display device (Col. 7, Lines 20-40).

Regarding Claim 73-75, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Autry further discloses a system wherein the remote control device has an input unit for generating pointer position information (See Figure 9B, 910) and selection information (913) as control information. The position of a pointer being able to

be set on a screen of the display device by means of the pointer position information in order to position the pointer on a specific display information on the display device and the position of the pointer being confirmed by means of the selection information is well known in the art. In the system of Autry, a track ball is shown that is used to move a cursor (Col. 11, Lines 24-29) and a trigger button (enter key) is shown that is used to select items on the screen (Col. 11, Lines 38-51).

Regarding Claim 76, Autry in view of Nemirofsky disclose a system as stated above in Claim 73. It is well known in the art that in such a system with a remote control (See Figure 9A) that there may be a cursor key block for generating the pointer position information. Autry further discloses a wireless keyboard for remote control of the system with a cursor key block (See Figure 10).

Regarding Claim 77, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Nemirofsky further discloses a system wherein electronic payment functions are implemented on the remote control device (Col. 4, Lines 39-47).

Regarding Claim 78, Autry in view of Nemirofsky disclose a system as stated above in Claim 77. Nemirofsky discloses a system wherein the electronic payment functions are implemented by means of an exchangeable chip card (See Figure 5 and 6a).

Regarding Claim 79, Autry in view of Nemirofsky disclose a system as stated above in Claim 63. Nemirofsky further discloses a system wherein the encrypting means are embodied on an exchangeable chip card (See Figures 5 and 6a).



Regarding Claim 80, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. The remote control device generates user-defined control signals for controlling the network computer as stated above in Claim 73.

Regarding Claim 81, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Nemirofsky discloses a system wherein the communication module incorporates a user identification module. Multiple account information is stored on the smart card (Col. 4, Lines 50-61) and a user initiates a financial transaction by providing input to the card (Col. 4, Lines 62-64) and entering a personal identification number (Col. 5, Lines 11-15).

Regarding Claim 82, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Nemirofsky discloses a system wherein the communication module incorporates a user identification module as stated above in Claim 81. The user enters a PIN code through the remote control device (See Figure 6a), which interfaces with the set top box to order Pay Per View programming as stated above. Because the remote/chip-card and set top box coordinate to initiate such a transaction, it is inherent that the remote control device incorporate some functions of the identification module.

Regarding Claim 83, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. Autry discloses a system wherein the base station is a personal computer (See Figure 1, 118) connected to a television set (150). It is well known in the art that a set top box is a computing device with a processor, memory, and input/output. Therefore, the system of Autry reads on the claimed set top box.

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7. Claims 65 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Autry et al. in view of Nemirofsky et al. and further in view of U.S. Patent No. 5,955,722 to Kurz et al.

Regarding Claim 65, Autry in view of Nemirofsky disclose a system as stated above in Claim 64. What is not disclosed, however, is that the CAM module comprises a chip card reader. Kurz discloses a system wherein a PC card is adapted to receive a chip card (See Figure 1). Kurz is evidence that ordinary workers in the art would recognize the benefit of being able to read a chip-card from a PCMCIA card. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the PC card system of Autry in view of Nemirofsky to accept the chip card as in the system of Kurz in order to have hot-swappable hardware-based user authentication and conditional access information in a small footprint, high-utility computing device.

Regarding Claim 67, Autry in view of Nemirofsky disclose a system as stated above in Claim 66. The remote control of Nemirofsky discloses a PC card (See Figure 5). Further, Autry in view of Nemirofsky and further in view of Kurz disclose a PC card adapted to receive a chip-card as stated above in Claim 65. This reads on the claimed CAM module comprising a chip-card reader.

8. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Autry et al. in view of Nemirofsky et al. and further in view of well known prior art.

Regarding Claim 70, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. What is not disclosed, however, is that the client network computer incorporates a JAVA engine. Official Notice is hereby taken that it is well known in the

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art that a computer-based multimedia system can incorporate a JAVA engine, either as a standalone application or as part of a web browser. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Autry in view of Nemirofsky with the JAVA engine of the well-known prior art in order to facilitate compatibility with a wide range of Internet-based multimedia applications.

9. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Autry et al. in view of Nemirofsky et al. and further in view of U.S. Patent No. 5,990,803 to Park.

Regarding Claim 71, Autry in view of Nemirofsky disclose a system as stated above in Claim 62. What is not disclosed, however, is the remote control device is provided with a fingerprint sensor for user identification. Park discloses a remote control device with fingerprint recognition for user identification purpose (Col. 1, Lines 56-65). Park is evidence that ordinary workers in the art would recognize the benefits of implementing fingerprint identification on a remote control device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the system of Autry in view of Nemirofsky with the fingerprint identification of Park in order to identify a user without the use of passwords which may be forgotten or chip-cards which may be lost or broken.

10. Claims 86 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky et al. in view of Kurz et al.

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Regarding Claims 86 and 88, Nemirofsky discloses a system as stated above in Claims 85 and 87. What is not disclosed, however, is that the chip-card reader is a plug-in PC Card. Kurz discloses a system wherein a PC card is adapted to receive a chip card (See Figure 1). Kurz is evidence that ordinary workers in the art would recognize the benefit of being able to read a chip-card from a PCMCIA card. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the PC card system of Nemirofsky to accept the chip card as in the system of Kurz in order to have hot-swappable hardware-based user authentication and conditional access information in a small footprint, high-utility computing device.

11. Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable Nemirofsky et al. in view of Autry et al.

Regarding Claim 89, Nemirofsky discloses a system as stated above in Claim 84. What is not disclosed, however, is a means for generating pointer position control data. Autry discloses a system with a remote control having means for generating pointer position control data as stated above in Claim 73. Autry is evidence that ordinary workers in the art would appreciate the ability to control a pointer on a screen with a remote control. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Nemirofsky with the pointer control of Autry in order to facilitate the usage of the remote control with an interactive graphical user interface such as an EPG or web browser.

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12. Claim 91 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky et al. in view of Park.

Regarding Claim 91, Nemirofsky discloses a system as stated above in Claim 84.

What is not disclosed, however, is a fingerprint sensor for user identification. Park discloses a remote control device with fingerprint recognition for user identification purpose (Col. 1, Lines 56-65). Park is evidence that ordinary workers in the art would recognize the benefits of implementing fingerprint identification on a remote control device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the system of Nemirofsky with the fingerprint identification of Park in order to identify a user without the use of passwords which may be forgotten or chip-cards which may be lost or broken.

### *Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 6,069,672 to Classen discloses a cordless remote control for a television receiver with a chip card reader for use in transmitting identification.

b. U.S. Patent No. 6,172,673 to Lehtinen et al. discloses a multimedia terminal for communication over a wireless network.

c. U.S. Patent No. 5,870,155 to Erlin discloses a television remote control with an IR transmitter and a credit card reader for home shopping. Also disclosed is a remote control with a trackball.

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d. U.S. Patent No. 5,905,521 to Gatto et al. discloses a multimedia system with a remote control comprising a chip-card reader and an identification module. Users identify themselves by the introduction of a chip-card. Further encryption of the bi-directional connection is disclosed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

MRD

mrdr  
August 13, 2003



ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600